

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MARNI INTERNATIONAL SA., LUXEMBOURG,  
PAZZALLO BRANCH,

Opposer,

v.

MARNA B. HILL,

Applicant



Opposition No. \_\_\_\_\_

Our Account No. 14-1140

Our Order No. 2865-405  
C# M#

Date: February 8, 2006

**Box TTAB Fee**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Sir:

The document indicated below is attached for filing and is incorporated by reference. Fees are attached as calculated below:

☒ NOTICE OF OPPOSITION in 6 class(es) (\$ 300.00 per class) (6402) \$ 1,800.00

☐ PETITION FOR CANCELLATION in 0 class(es) (\$ 300.00 per class)(6401) \$ 0.00

**TOTAL FEE ENCLOSED \$ 1,800.00**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this form) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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**NIXON & VANDERHYE P.C.**

By Atty: Frank P. Presta

Signature: Frank P. Presta

In the Matter of Application Serial No. 75/895,386  
Published in the Official Gazette on January 10, 2006

**SECRET**

J. Patent &amp; TMO/c/TM Mail Rcpt Dt. #11

Opposition No. \_\_\_\_\_

Docket No. 2865-405

**Applicant.**

## 434759

As grounds for opposition, it is alleged that:

1. Application Serial No. 75/895,386 was filed on January 13, 2000 based on intent-to-use for the following goods:

LEATHER SHOPPING BAGS, TRAVEL BAGS, UMBRELLAS, AND LUGGAGE, in CLASS 18;

FURNITURE, MIRRORS, PICTURE FRAMES; WOOD GOODS, NAMELY, WOOD FIGURINES, BOXES AND CARVINGS; WICKER GOODS, NAMELY, WICKER FURNITURE; PLASTIC GOODS, NAMELY, PLASTIC CRATES AND FIGURINES, in CLASS 20;

HOUSEHOLD AND KITCHEN UTENSILS, NAMELY, POT AND PAN SCRAPES, ROLLING PINS, SPATULAS, TURNERS AND WHISKS; BEVERAGE GLASSWARE; CERAMIC AND PORCELAIN BOWLS, PLATES, VASES, MUGS AND STATUES; WICKER GOODS, NAMELY, WICKER BASKETS, in CLASS 21;

TEXTILE GOODS, NAMELY, TEXTILE NAPKINS, PLACE MATS AND WALL HANGINGS; BED AND TABLETOP LINENS, in CLASS 24;

CLOTHING, NAMELY, SHIRTS, PANTS AND SHORTS; FOOTWEAR AND HEADWEAR, in CLASS 25; and

VINYL FLOOR COVERINGS, CARPET, RUGS; WALL HANGINGS, NOT OF TEXTILE, in CLASS 27.

2. Upon information and belief, Applicant has not used the mark MARNA & Design in commerce on any of the goods in Application Serial No. 75/895,386 prior to the filing date of January 13, 2000.

3. Opposer and its predecessors in interest have used the mark MARNI in commerce continuously from at least as early as 1992 on various items of clothing for men, women and children, and thereafter on various goods in International Classes 3, 9, 14, 18 and 27, as well as on other goods.

4. Opposer is the owner of Registration No. 1609845, dated August 14, 1990, for the mark MARNI & Design for the following goods:

CLOTHES MADE OF LEATHER - NAMELY, COATS, JACKETS, PANTS, SKIRTS, HATS, CAPS AND SHORTS, CLOTHES FOR MEN, WOMEN, AND CHILDREN, NAMELY SHIRTS, BLOUSES, SKIRTS, JACKETS, PANTS, SHORTS, UNDERSHIRTS, PAJAMAS, STOCKINGS, GIRDLES, GARTERS, SLIPS, SLIPPERS, SHOES, FOOTWEAR, HATS, SCARFS, FOULARDS, TIES, OVERCOATS, RAINCOATS, BATHING SUITS, OVERALLS, WIND-RESISTANT JACKETS, SKI-PANTS, BELTS AND FUR COATS, in CLASS 25.

5. Opposer is the owner of Registration No. 2339848, dated April 11, 2000, for the mark MARNI for the following goods:

LAUNDRY DETERGENTS; BLEACHING PRODUCTS, NAMELY, LAUNDRY BLEACH; SOFTENING PRODUCTS, NAMELY, LIQUID FABRIC SOFTENER; SOAPS, NAMELY, SKIN SOAP AND TOILET SOAP; PERFUMERY ARTICLES, NAMELY, COLOGNE, EAU DE TOILETTE; PERFUMES; ESSENTIAL OILS FOR PERSONAL USE; COSMETICS, NAMELY, MASCARA, LIPSTICK; HAIR LOTIONS; TOOTH PASTES, in CLASS 3; and

BAGS, NAMELY, ALL PURPOSE ATHLETIC BAGS; HANDBAGS; SUITCASES; BRIEFCASES; PURSES; DOCUMENT CASES; DOCUMENT HOLDERS; GARMENT

BAGS FOR TRAVEL; LUGGAGE TRUNKS; ANIMAL SKIN; LEATHER SOLD IN BULK; IMITATION LEATHER SOLD IN BULK; PARASOLS; SUN UMBRELLAS, NAMELY, GOLF UMBRELLAS, PATIO UMBRELLAS; UMBRELLAS; WALKING STICKS; HARNESES AND SADDLERY, in CLASS 18.

6. Opposer is the owner of Registration No. 2841412, dated May 11, 2004 for the mark MARNI for the following goods:

OPTICAL INSTRUMENTS, APPARATUS AND EQUIPMENT, NAMELY GLASSES, SUNGLASSES, SPECTACLES AND SPECTACLE FRAMES, in CLASS 9;

PRECIOUS METALS AND THEIR ALLOYS; GOODS OF PRECIOUS METALS OR COATED THEREWITH, NAMELY NECKLACES, EARRINGS, BRACELETS, BROACHES, RINGS, NECKTIE PINS, BADGES OF PRECIOUS METAL, MEDALLIONS, BELT BUCKLES OF PRECIOUS METAL FOR CLOTHING, JEWELRY, PRECIOUS GEMSTONES, WATCHES, CLOCKS AND CHRONOMETERS, in CLASS 14;

CLOTHING FOR MEN, WOMEN AND CHILDREN; NAMELY BELTS, COATS, RAINCOATS, WAISTCOATS, BLOUSES AND PULLOVERS, JACKETS, TROUSERS, SKIRTS, DRESSES, SUITS, SHIRTS AND CHEMISES, T-SHIRTS, SWEATERS, UNDERWEAR, SOCKS AND STOCKINGS, GLOVES, TIES, SCARVES, HATS AND CAPS, BOOTS, SHOES AND SLIPPERS, in CLASS 25; and

CARPETS; TEXTILE, VINYL AND CLOTH WALL COVERINGS; AND PLASTIC BATH MATS, in CLASS 27.

7. By virtue of the marketing and sale in commerce by Opposer and its predecessors in interest of a wide variety of goods under the mark MARNI, such goods

have acquired a favorable reputation reflected in a substantial amount of goodwill which will be severely impaired by the registration of the very similar mark MARNA to Applicant for similar goods.

8. Applicant's mark MARNA is so similar to Opposer's mark MARNI when used on the same or related goods, as to be very likely to cause confusion, mistake or lead to deception as to the source or origin of Applicant's goods when sold under its MARNA mark.

9. The goods on which Applicant's mark MARNA is intended to be used, and the goods on which Opposer's mark MARNI is used or registered, are closely related goods which are sold, distributed and advertised through the same channels of trade and to the same classes of purchasers. Accordingly, confusion, mistake or deception are most likely, and many persons familiar with Opposer's mark MARNI are likely to buy Applicant's products under the mark MARNA in the belief that the latter are products sold or authorized by Opposer.

10. By the grant of a registration for the mark MARNA, Applicant will obtain at least *prima facie* the exclusive right to use this mark on the goods in International Classes 18, 20, 21, 24, 25 and 27 in its application. Such registration will be a source of damage and injury to Opposer and to its customers who have traded with Opposer based on reliance on its MARNI mark.

A duplicate copy of this Notice of Opposition is filed herewith, along with a check for the Opposition fee of \$1,800.00 (6 classes).

WHEREFORE, Opposer prays that this Opposition be sustained and that registration of the mark MARNA in Application Serial No. 75/895,386 be refused to Applicant.

Respectfully submitted,

Date: February 8, 2006

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